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10/763,033	01/22/2004	Donald F. Wilson JR.	59474.21800	6981

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BAKER & HOSTETLER LLP  
WASHINGTON SQUARE, SUITE 1100  
1050 CONNECTICUT AVE. N.W.  
WASHINGTON, DC 20036-5304

EXAMINER
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RYCKMAN, MELISSA K

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/763,033

**Applicant(s)**

WILSON, DONALD F.

**Examiner**

Melissa Ryckman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/4/04 and 4/7/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to applicants' response filed 11/28/06. Claims 1-30 are pending in this application.

The terminal disclaimer filed on 11/28/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,863,375 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The disclaimer fee of \$130 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5, 12-14, 17, 19, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Small (US 2003/0069589 A1).

3. Small discloses a clip with an integral cutting guide including a first leg (12) and second leg (11) joined by a flexible hinge (13), cutting guides (17) extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs, and a female locking member (recess 19) and male locking member (hook 18), the male locking member is lockingly engaged in said female locking member so as to removably lock said first and second leg members of said surgical clip in said closed position. At least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

4. Regarding claim 2 Small discloses a clip as referred to in claim 1 where at least one cutting guide comprises a plurality of cutting guides, wherein said first and second legs each have at least one of said plurality of cutting guides disposed thereon (17 attached to legs 11 and 12).

5. Regarding claim 3 Small discloses a clip as referred to in claim 2 where at least one of said cutting guides is disposed on each of said opposing side surfaces (17 see Figures 2 and 3).

6. Regarding claim 5 Small discloses a clip as referred to in claim 1 where at least one cutting guide has an elongated shape where the length of the cutting guide is larger than the width of the cutting guide (Figures 2 and 3).

7. Regarding claim 12 Small discloses a clip as referred to in claim 1 where at least one inner surface has a plurality of protrusions (14) extending from the inner surface.

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8. Regarding claim 13 Small discloses a clip as referred to in claim 12 where both of the inner surfaces have a plurality of protrusions (14) extending from the inner surface (Figure 1).

9. Regarding claim 14 Small discloses a clip as referred to in claim 1 where the hinge section has a continuous concave inner surface and continuous convex outer surface (13 see Figure 1).

10. Regarding claim 17 Small discloses a clip with an integral cutting guide including a first leg (12) and second leg (11) joined by a flexible hinge (13), a plurality of cutting guides (17) extend outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs, and a female locking member (recess 19) and male locking member (hook 18), the male locking member is lockingly engaged in said female locking member so as to removably lock said first and second leg members of said surgical clip in said closed position. At least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

11. Regarding claim 19 Small discloses a clip as referred to in claim 17 where at least one cutting guide has an elongated shape where the length of the cutting guide is larger than the width of the cutting guide (Figures 2 and 3).

12. Regarding claim 26 Small discloses a clip as referred to in claim 17 where at least one inner surface has a plurality of protrusions (14) extending from the inner surface.

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13. Regarding claim 27 Small discloses a clip as referred to in claim 26 where both of the inner surfaces have a plurality of protrusions (14) extending from the inner surface (Figure 1).

14. Regarding claim 28 Small discloses a clip as referred to in claim 17 where the hinge section has a continuous concave inner surface and continuous convex outer surface (13 see Figure 1).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 4, 6-11, 15-18, 20-25, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh et al. (U.S. Patent No. 5,062,846) in view of Small (US 2003/0069589 A1).

17. Regarding claim 1 Oh et al. discloses a surgical clip with an integral cutting guide including a first leg (12) and second leg (14) joined by a flexible hinge (16), and a female locking member (hook member 22) and male locking member (beveled surface 48), the male locking member is lockingly engaged in said female locking member so as to removably lock said first and second leg members of said surgical clip in said closed position. Oh et al. does not teach cutting guides extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at

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least one of said first and second legs. Small teaches cutting guides (17, Fig. 1) extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs. Small teaches at least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

18. The combination of Oh et al. and Small would have been obvious to one of ordinary skill in the art as the wings provided in Small for gripping are capable of being used as cutting guides because of their size and shape.

19. Regarding claim 6 Oh et al. discloses a surgical clip where a pair of bosses (68 and 70) is joined on opposite side of the first leg, between the hinge and distal end, a pair of opposing bosses is located on the second leg (72 and 74).

20. Regarding claim 7 Oh et al. does not have at least one cutting guide located on opposite side surfaces between the hinge and the bosses. However, Small discloses a surgical clip as referred to in claim 6 where at least one cutting guide is located on opposite side surfaces between the hinge and the bosses (Fig 1, 17).

The combination of Oh et al. and Small would have been obvious to one of ordinary skill in the art because there would be an addition of cutting guides therefore the cut can be made in a more exact and controlled manner.

21. Regarding claim 8 Oh et al. discloses a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces (See Figures 2 and 3 and Claim 9).

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22. Regarding claim 9 Oh et al. discloses a surgical clip where the pair of bosses (68 and 70) on the first leg extends past the outer surface of the leg to form a bridge section (col. 6 ll. 24-26).

23. Regarding claim 10 Oh et al. discloses a surgical clip where the pair of bosses on the second leg (72 and 74) that have a sharp tissue-penetrating tooth extending outwardly from the first leg (81 and 83).

24. Regarding claim 11 Oh et al. discloses a surgical clip where the inner surface of said first leg (20) has a concave radius of curvature between said hinge section and its distal end, said outer surface of said first leg (30) has a convex radius of curvature between said hinge section and its distal end, said inner surface of said second leg (24) has a convex radius of curvature between said hinge section and its distal end, and said outer surface of said second leg (38) has a concave radius of curvature between said hinge section and its distal end.

25. Regarding claim 15 Oh et al. discloses a surgical clip where the female locking member comprises a resiliently inwardly turned hook (22), curved towards the second leg.

Regarding claim 16 Oh et al. discloses a surgical clip where the male locking member (48) is complementary to the female locking member, when the clip is in the closed position the hook of the female locking member contacts the male locking member and is urged open to receive the male locking member so the lock is removable.



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26. Regarding claim 17 Oh et al. discloses a surgical clip with an integral cutting guide including a first leg (12) and second leg (14) joined by a flexible hinge (16), , and a female locking member (hook member 22) and male locking member (beveled surface 48), the male locking member is lockingly engaged in said female locking member so as to removably lock said first and second leg members of said surgical clip in said closed position. Oh et al. does not have a plurality of cutting guides extending outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs. However, Small teaches a plurality of cutting guides (Fig. 1, 17) extend outward from and disposed along at least a portion of the length of at least one of said opposing side surfaces on at least one of said first and second legs. Small teaches at least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

The combination of Oh et al. and Small would have been obvious to one of ordinary skill in the art because there would be an addition of cutting guides therefore the cut can be made in a more exact and controlled manner.

27. Regarding claim 20 Oh et al. discloses a surgical clip where a pair of bosses (68 and 70) is joined on opposite side of the first leg, between the hinge and distal end, a pair of opposing bosses is located on the second leg (72 and 74).

28. Regarding claim 21 Oh et al. does not have at least one cutting guide located on opposite side surfaces between the hinge and the bosses. However, Small discloses a

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surgical clip where at least one cutting guide (Fig. 1, 17) is located on opposite side surfaces between the hinge and the bosses.

29. The combination of Oh et al. and Small would have been obvious to one of ordinary skill in the art because there would be an addition of cutting guides therefore the cut can be made in a more exact and controlled manner.

30. Regarding claim 22 Oh et al. discloses a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces (See Figures 2 and 3 and Claim 9).

### ***Double Patenting***

31. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

32. Claims 1-3, 6-13, 15-17, 20-27, 29, and 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of Wilson, Jr.(U.S. Patent No. 6,863,675) in view of Small (US 2003/0069589).

33. Claim 1 discloses a surgical clip with an integral cutting guide, comprising: a first and second leg with the inner surfaces being positioned opposite of each other (Claim 1 col. 7 ll. 66 and col. 8 ll. 1-3); a flexible hinge section between and joining the two legs (Claim 1 col. 7 ll. 65, 66); a female locking member and male locking member positioned at the distal ends of different legs, the male locking member is engaged in the female locking member when in the closed position, the female member can be removable locked (Claim 1 col. 8 ll. 4-12). Wilson, Jr. does not have at least one cutting guide extending outward on a portion of at least one of the legs. However, Small

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teaches at least one cutting guide extending outward on a portion of at least one of the legs (Small 17). Small teaches at least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

34. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the wings provided in Small can be used as cutting guides if applied to the clip of Wilson, Jr.

35. Regarding claim 2 Wilson, Jr. does not have a surgical clip where at least one cutting guide comprises a plurality of cutting guides, where each leg has at least one cutting guide. However, Small teaches a surgical clip where at least one cutting guide comprises a plurality of cutting guides, where each leg has at least one cutting guide (Small 17).

36. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the wings provided in Small can be used as cutting guides if applied to the clip of Wilson, Jr. A plurality of cutting guides would be useful so there would be more places to hold onto the clip.

37. Regarding claim 3 Wilson, Jr. does not disclose a surgical clip where at least one cutting guide is on each of the opposing side surfaces. However, Small discloses a surgical clip where at least one cutting guide is on each of the opposing side surfaces (Small 17).

38. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the wings provided in Small can be used as cutting guides if

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applied to the clip of Wilson, Jr. Cutting guides on opposing side surfaces would be useful as this is more ergonomic.

39. Regarding claim 6 Wilson, Jr. discloses a surgical clip where a pair of bosses is joined on opposite side of the first leg, between the hinge and distal end, a pair of opposing bosses is located on the second leg (Claim 4 col. 8 ll. 46-49).

40. Regarding claim 7 Wilson, Jr. does not have a surgical clip where at least one cutting guide is located on opposite side surfaces between the hinge and the bosses. Wilson, Jr. discloses bosses located near the distal ends (Claim 4 col. 8 ll. 46-49) and Small discloses wings (Small Claim 9) between the hinge and locking member.

41. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art. This combination is motivated by the fact that the bosses are located at the distal end and the wings are located between the hinge and the distal end, as there is no overlap between the wings and the bosses, therefore both can co-exist.

42. Regarding claim 8 Wilson, Jr. does not have a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces. However, Small teaches a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces (Small Claim 9).

43. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the most logical placement of the cutting guides would be

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adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces.

44. Regarding claim 9 Wilson, Jr. discloses a surgical clip where the pair of bosses on the first leg extends past the outer surface of the leg to form a bridge section (col. 8 ll. 47, 48).

45. Regarding claim 10 Wilson, Jr. discloses a surgical clip where the pair of bosses on the second leg have a sharp tissue-penetrating tooth extending outwardly from the first leg (col. 8 ll. 57-60).

46. Regarding claim 11 Wilson, Jr. discloses a surgical clip where the inner surface of the first leg has a concave radius of curvature between the hinge and the distal end, the outer surface has a convex radius of curvature between the hinge and the distal end, the inner surface of the second leg has a convex radius of curvature between the hinge and the distal end, and the outer surface of the second leg has a concave radius of curvature between the hinge and the distal end (col. 8 ll. 27-35).

47. Regarding claim 12 Wilson, Jr. discloses a surgical clip where at least one of the inner surfaces comprises a plurality of protrusions (col. 8 ll. 53-55).

48. Regarding claim 13 Wilson, Jr. discloses a surgical clip where both of the inner surfaces comprise of a plurality of protrusions (col. 8 ll. 53-55).

49. Regarding claim 15 Wilson, Jr. discloses a surgical clip where the female locking member comprises a resiliently inwardly turned hook, curved towards the second leg (col. 8 ll. 4,5).

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50. Regarding claim 16 Wilson, Jr. discloses a surgical clip where the male locking member is complementary to the female locking member, when the clip is in the closed position the hook of the female locking member contacts the male locking member and is urged open to receive the male locking member so the lock is removable (col. 8 ll. 6-11).

51. Regarding claim 17 Wilson, Jr. discloses a surgical clip with an integral cutting guide, comprising: a first and second leg with the inner surfaces being positioned opposite of each other (Claim 1 col. 7 ll. 66 and col. 8 ll. 1-3); a flexible hinge section between and joining the two legs (Claim 1 col. 7 ll. 65, 66); a female locking member and male locking member positioned at the distal ends of different legs, the male locking member is engaged in the female locking member when in the closed position, the female member can be removable locked (Claim 1 col. 8 ll. 4-12). Wilson, Jr. does not have at least one cutting guide extending outward on a portion of at least one of the legs. However, Small teaches at least one cutting guide extending outward on a portion of at least one of the legs (Small 17). Small teaches at least one cutting guide includes a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig. 5).

52. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the wings provided in Small can be used as cutting guides if applied to the clip of Wilson, Jr.

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53. Regarding claim 20 Wilson, Jr. discloses a surgical clip where a pair of bosses is joined on opposite side of the first leg, between the hinge and distal end, a pair of opposing bosses is located on the second leg (Claim 4 col. 8 ll. 46-49).

54. Regarding claim 21 Wilson, Jr. does not have a surgical clip where at least one cutting guide is located on opposite side surfaces between the hinge and the bosses. Wilson, Jr. discloses bosses located near the distal ends (Claim 4 col. 8 ll. 46-49) and Small discloses wings (Small Claim 9) between the hinge and locking member.

55. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art. This combination is motivated by the fact that the bosses are located at the distal end and the wings are located between the hinge and the distal end, as there is no overlap between the wings and the bosses, therefore both can co-exist.

56. Regarding claim 22 Wilson, Jr. does not have a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces. However, Small teaches a surgical clip where one cutting guide is adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces (Small Claim 9).

57. The combination of Wilson, Jr. and Small would have been obvious to one of ordinary skill in the art as the most logical placement of the cutting guides would be adjacent to the hinge section along at least a portion of the length of at least one of the opposing side surfaces.



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58. Regarding claim 23 Wilson, Jr. discloses a surgical clip where the pair of bosses on the first leg extends past the outer surface of the leg to form a bridge section (col. 8 ll. 47, 48).

59. Regarding claim 24 Wilson, Jr. discloses a surgical clip where the pair of bosses on the second leg have a sharp tissue-penetrating tooth extending outwardly from the first leg (col. 8 ll. 57-60).

60. Regarding claim 25 Wilson, Jr. discloses a surgical clip where the inner surface of the first leg has a concave radius of curvature between the hinge and the distal end, the outer surface has a convex radius of curvature between the hinge and the distal end, the inner surface of the second leg has a convex radius of curvature between the hinge and the distal end, and the outer surface of the second leg has a concave radius of curvature between the hinge and the distal end (col. 8 ll. 27-35).

61. Regarding claim 26 Wilson, Jr. discloses a surgical clip where at least one of the inner surfaces comprises a plurality of protrusions (col. 8 ll. 53-55).

62. Regarding claim 27 Wilson, Jr. discloses a surgical clip where both of the inner surfaces comprise of a plurality of protrusions (col. 8 ll. 53-55).

63. Regarding claim 29 Wilson, Jr. discloses a surgical clip where the female locking member comprises a resiliently inwardly turned hook, curved towards the second leg (col. 8 ll. 4,5).

Regarding claim 30 Wilson, Jr. discloses a surgical clip, where the male locking member is complementary to the female locking member, when the clip is in the closed position the hook of the female locking member contacts the male locking member and

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is urged open to receive the male locking member so the lock is removable (col. 8 ll. 6-11).

64. Regarding claim 23 Oh et al. discloses a surgical clip where the pair of bosses (68 and 70) on the first leg extends past the outer surface of the leg to form a bridge section (col. 6 ll. 24-26).

65. Regarding claim 24 Oh et al. discloses a surgical clip where the pair of bosses on the second leg (72 and 74) that have a sharp tissue-penetrating tooth extending outwardly from the first leg (81 and 83).

66. Regarding claim 25 Oh et al. discloses a surgical where the inner surface of said first leg (20) has a concave radius of curvature between said hinge section and its distal end, said outer surface of said first leg (30) has a convex radius of curvature between said hinge section and its distal end, said inner surface of said second leg (24) has a convex radius of curvature between said hinge section and its distal end, and said outer surface of said second leg (38) has a concave radius of curvature between said hinge section and its distal end.

67. Regarding claim 29 Oh et al. discloses a surgical clip where the female locking member comprises a resiliently inwardly turned hook (22), curved towards the second leg.

Regarding claim 30 Oh et al. discloses a surgical clip where the male locking member (48) is complementary to the female locking member, when the clip is in the closed position the hook of the female locking member contacts the male locking

member and is urged open to receive the male locking member so the lock is removable.

68. Claims 4 and 18 are rejected because Small (U.S. Application No. US 2003/0069589) discloses the claimed invention except for the dimension of the cutting guide being 3.0 mm from the side surface. It would have been obvious matter of design choice to adopt Small's design (Figure 1) to obtain a different distance from the clip in which the cut would be guided, since such a modification would have involved a slight change in the size of this component to achieve properties obvious to one of ordinary skill in the art. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose* 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

Applicant's arguments filed 11/28/06 have been fully considered but they are not persuasive. The applicant argues the following points:

- A cutting guide needs to have a flat, smooth edge to allow cutting.
- The "thumb wing" of small is not at all related to providing a cutting guide.
- The combined references (Small and Oh) do not teach the disclosed inventions of claims 1 and 17.

The examiner respectfully disagrees concerning the cutting guide since a cutting guide does not need to have a flat, smooth edge to allow cutting, it may be preferable but it does not need to have the previously stated characteristics. The "thumb wing" of Small may be used for a cutting guide.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Ryckman whose telephone number is (571)-272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571)-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR

A handwritten signature in black ink, appearing to read "M. J. Hayes", with a stylized flourish at the end.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER